

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District of California on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. CV 10-05210 PJH	DATE FILED 11/17/2010	U.S. DISTRICT COURT Oakland Division, 1301 Clay Street, Suite 400S, Oakland, CA 94612
PLAINTIFF San Francisco Technology, Inc.		DEFENDANT Franklin Sports, Inc
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 4,801,144		
2 D323,369		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1			
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT **See Attached Order of Transfer

CLERK Richard W. Wieking	(BY) DEPUTY CLERK Valerie Kyono	DATE March 25, 2011
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

ADR

E-FILING

E-FILING

FILED

NOV 17 2010

RICHARD W. WICKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

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11/17/10
PVT

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Counsel for San Francisco Technology Inc.

U.S. District Court
Northern District of California

San Francisco Technology Inc.

Plaintiff

vs.

Franklin Sports, Inc.

Defendant

Case No. **CV 10-05210**

Complaint

PVT

Demand For Jury Trial

MOUNT & STOELKER, P.C.
RIVERPARK TOWER, SUITE 1650
333 WEST SAN CARLOS STREET
SAN JOSE, CALIFORNIA 95110-2740
TELEPHONE (408) 279-7000

1 *Qui tam* relator San Francisco Technology Inc. ("SF Tech") files this Complaint against
2 defendant Franklin Sports, Inc. ("Franklin Sports") and alleges as follows:

3 Nature of Action

4 1. This is a *qui tam* action to impose civil fines for false marking. As alleged further
5 below, Franklin Sports has falsely marked articles in violation of 35 U.S.C. § 292 and must be civilly
6 fined for each offense: "Whoever marks upon, or affixes to, or uses in advertising in connection with
7 any unpatented article, the word 'patent' or any word or number importing that the same is patented,
8 for the purpose of deceiving the public ... Shall be fined not more than \$500 for every such offense."
9 Franklin Sports has falsely marked products with patents to induce the public to believe that each
10 such product is protected by each patent listed and with knowledge that nothing is protected by an
11 expired patent. Accordingly, Franklin Sports falsely marked articles with intent to deceive the public.

12 Parties

13 2. Plaintiff San Francisco Technology is a California corporation with its principal place
14 of business in San Jose, California.

15 3. Upon information and belief, Franklin Sports is a Delaware corporation with its
16 principal place of business at 17 Campanelli Parkway, Stoughton, MA, 02072.

17 Jurisdiction & Venue

18 4. This court has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1338(a) and
19 1355(a).

20 5. Venue is appropriate in this District under 28 U.S.C. §§ 1391(b) and 1395(a).

21 6. Upon information and belief, this court has personal jurisdiction over Franklin Sports
22 because Franklin Sports has sold its products, including its falsely marked products in California and
23 in this District and/or in the stream of commerce with knowledge that they would be sold in
24 California and in this District. Upon information and belief, such sales are substantial, continuous,
25 and systematic. Franklin Sports advertises its products, including its falsely marked products on its
26 web site, at www.franklinsports.com. Franklin Sports advertises on that web site that its products are
27 sold at many retail store chains which have locations in California and in this District, including
28

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1 Sports Authority, Dick's Sporting Goods, JCPenney, and Target.¹

2 **Intradistrict Assignment**

3 7. This case is appropriate for District-wide assignment under Civil Local Rule 3-2(c)
4 because the claims in this Complaint arise under 35 U.S.C. § 292, which is codified with the patent
5 statutes.

6 **Franklin Sport's False Marking**

7 8. SF Tech incorporates by reference all above allegations.

8 9. Upon information and belief, Franklin Sports makes and sells many types of products,
9 including the SX Street Extreme Pro Street Hockey "Roll-A-Puck" (the "Accused Product").

10 10. Franklin Sports causes or contributes to the marking and advertising of products with
11 the U.S. Patent Nos. 4,801,144 and D323,369, including, but not limited to, the Accused Product.

12 11. U.S. Patent No. 4,801,144, entitled "Hockey puck", issued on January 31, 1989. U.S.
13 Patent No. D323,369, also entitled "Hockey puck", issued on January 21, 1992.

14 12. Franklin Sports individually marks the Accused Product: "US Pat. 4,801,144", US
15 Pat. D-323369", and "Canadian Pat 62392."

16 13. On its website, Franklin Sports advertises the Accused Product as including the
17 "Patented ROLL-A-PUCK design."² The web page dedicated to the Accused Product depicts four
18 units of the Accused Product. On two of the pucks, the words "US PATENT NUMBER 4801144"
19 are clearly visible. Franklin Sports designed this advertisement in a manner that makes this marking
20 easily visible.

21 14. U.S. Patent Nos. 4,801,144 and D323,369 are expired patents. Upon information and
22 belief, U.S. Patent No. 4,801,144 expired no later than September 2, 2007. Upon information and
23 belief, U.S. Patent No. D323,369 expired no later than January 22, 2006.

24 15. Franklin Sport's falsely marked products are being sold in 2010 with such false
25 markings, after the expiration of U.S. Patent Nos. 4,801,144 and D323,369.

26 16. Franklin Sports is a sophisticated company and has many years of experience applying
27 for, obtaining, and maintaining patents. Franklin Sports also has extensive experience manufacturing
28

¹ <http://www.franklinsports.com/fsm/b2c/Franklin-Sports-Retailers.htm>

² <http://www.franklinsports.com/fsm/b2c/streethockey/2010/12241.html>

1 products and either marking or not marking them with words or numbers indicating that such
2 products are protected by patents or pending applications.

3 17. Upon information and belief, Franklin Sports (including Franklin Sports' patent
4 counsel) knew or should have known that the term of U.S. Patent Nos. 4,801,144 and D323,369
5 expired no later than their expiration dates.

6 18. Franklin Sports is no longer paying maintenance fees to the United States Patent and
7 Trademark Office to maintain U.S. Patent No. 4,801,144.

8 19. Upon information and belief, Franklin Sports knew or should have known that U.S.
9 Patent Nos. 4,801,144 and D323,369 had already expired at the same time Franklin Sports was
10 marking and advertising products with U.S. Patent Nos. 4,801,144 and D323,369.

11 20. Franklin Sports knows, or at least reasonably should know, that U.S. Patent Nos.
12 4,801,144 and D323,369 do not protect the Accused Product, or any products whatsoever.

13 21. Franklin Sports could have no reasonable belief that it was proper to mark and
14 advertise products with the numbers of the expired U.S. Patent Nos. 4,801,144 and D323,369, and the
15 false marking was done with intent to deceive the public by, including, but not limited to, misusing
16 its patent rights to extend the term of its patents and inhibiting competition.

17 22. For at least the reasons set forth herein, Franklin Sports has wrongfully and illegally
18 advertised patent rights which it does not possess, and, as a result, has likely benefited in at least
19 maintaining its market share in the marketplace.

20 23. For at least the reasons set forth herein, Franklin Sports has wrongfully and illegally
21 advertised patent rights which it does not possess, and, as a result, has likely caused the retail price of
22 its Accused Product to be inflated above normal market levels, and has caused the public to face
23 inflated prices for its products.

24 24. The public deception, and/or competitive harm caused by each of Franklin Sports'
25 false markings has and continues to harm the United States and the public, including relator SF Tech,
26 a representative of the public incurring the cost and time associated with this enforcement.

27 **Demand For Judgment**

28 SF Tech demands judgment against Franklin Sports, as follows:

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1. A declaration that Franklin Sports violated 35 U.S.C. § 292.
2. An accounting of the number, sales, and revenue of any falsely marked articles not presented at trial.
3. A civil fine of \$500 for each offense — half paid to the U.S., and half paid to SF Tech.
4. Costs, including attorney fees.
5. A finding that this is an exceptional case.
6. Any other relief the court deems appropriate.

Demand For Jury Trial

SF Tech demands a jury trial on all issues so triable.

Date: November 17, 2010

Mount & Stoelker, P.C.,


Counsel for San Francisco Technology Inc.

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Attorneys for Defendant
Franklin Sports, Inc.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

SAN FRANCISCO TECHNOLOGY, INC.

Plaintiff,

vs.

FRANKLIN SPORTS, INC.

Defendant.

Case No. C10-05210 PJH

**STIPULATION OF TRANSFER
AND ORDER**

Judge: Hon. Phyllis J. Hamilton

1 Plaintiff San Francisco Technology, Inc. ("SF Tech") and Defendant Franklin Sports, Inc.
2 ("Franklin"), by and through their respective counsel, jointly stipulate as follows.

3 WHEREAS Franklin filed a motion seeking dismissal of SF Tech's claims against
4 Franklin pursuant to Fed. R. Civ. P. 9(b) and 12(b)(6), and, in the alternative, to transfer this
5 action to the United States District Court for the District of Massachusetts pursuant to 28 U.S.C. §
6 1404(a) (D.I. 19).

7 WHEREAS SF Tech does not oppose Franklin's request to transfer venue to the District of
8 Massachusetts.

9 NOW THEREFORE, IT IS HEREBY STIPULATED by and between counsel for the
10 undersigned parties as follows:

- 11 1. The court may transfer this case to the United States District Court for the District of
12 Massachusetts; and
13 2. Franklin's Motion to Dismiss is deferred for ruling by the District of Massachusetts.
14

15 **SIGNATURES**

16 In accordance with General Order 45.X.B., Gerald B. Hryczyn, counsel for Franklin,
17 attests that each other signatory listed below has concurred in this filing.
18

19 Date: March 23, 2011

Mount, Spelman & Fingerman, P.C.,

/s/ Daniel H. Fingerman

Counsel for San Francisco Technology, Inc.

21 Date: March 23, 2011

Wolf, Greenfield & Sacks, P.C.

/s/ Gerald B. Hryczyn

Counsel for Franklin Sports Inc.

23
24 PURSUANT TO STIPULATION, IT IS SO ORDERED. This case will be transferred to the
25 District of Massachusetts and the Motion to Dismiss deferred for ruling by the District of
26 Massachusetts.

27 Dated: 3/23/11

28 HON. PHYLLIS J. HAMILTON
United States District Court

